

### **REMARKS**

Claims 1-4 remain in this application. Claims 1-4 are rejected. Claim 1 is objected to. Claims 1-4 are amended herein to clarify the invention and to address matters of form unrelated to substantive patentability issues. For example, reference numerals are removed as the elements of the claims are not considered limited to specific corresponding structures in the drawings. Other formal matters are attended to that were not addressed by the Examiner and accordingly are considered unrelated to substantive patentability issues. For the convenience of the Examiner, APPENDIX I is provided herewith having a complete set of pending claims with all amendments effected therein.

### **CLAIM OBJECTIONS**

Claim 1 is objected to for the recitation of a “concave” groove. This terminology is now removed and replaced with the broader terminology “annular recess.” Withdrawal of the objection is respectfully requested.

### **DRAWING OBJECTIONS**

**AMENDMENTS TO THE DRAWINGS:**

Please find accompanying this response replacement sheets for Figs. 1, 2(a) and 2(b) wherein amendments explained in the Remarks presented below are effected.

The drawings are objected to. The Office Action states that the legend "Prior Art" is required on Figs. 1, 2(a) and 2(b) to clarify the invention. Replacement drawing sheets of Figs. 1, 2(a) and 2(b) accompany this amendment wherein the legend "Prior Art" is added.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)**

Claims 1-5 are rejected as obvious over the Wada reference in view of the Nakano reference under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness cannot be established in rejection of claims 1-4. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

Claim 1 is now amended to replace "concave groove" with "annular recess" Nowhere in the references is there shown a lens barrel with an annular recess filled with adhesive. The groove cited in the Wada reference is referred to in the Office Action as "the indentation of flange "204b." The portion 204b is a peripheral portion of a *lens* fitted groove in a lens and does not present a barrel with an annular recess filled with adhesive and a fitted portion. Furthermore, the fitted lens 205 which is adhered to the lens 204 by adhesive 205 in no way suggests the claimed "raised annular portion extending axially and disposed radially inward of said adhering portion" wherein the "adhering portion to be adhered to the lens-barrel" is "an axially extending surface radially opposing said annular recess inner surface" of the annular groove.

The Nakano reference also totally fails to show a groove in an inner peripheral surface of a lens barrel filled with adhesive. The reference states that the lens barrel 4 has a groove in which the lens 1 is fitted and is held by adhesive 7. However, it is clear that the "groove" referred to is merely a fitted portion and there is no teaching of an annular recess in addition to the fitted portion as claimed.

Still further, the adhesive 7 is simply shown between the 1 and a second lens barrel 5 and in no way is located in an annular recess. Thus, nothing in the references would lead one to arrive at the present invention. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416, 420 (Fed. Cir. 1986) citing *In re Wesslau*, 353 F2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 1-4 and their allowance are respectfully requested.

Applicant's attorney has contacted the Examiner and attempted to arrange an interview regarding the above matter. Unfortunately, the Examiner was unable to schedule the interview before the filing of this amendment. Therefore, it is respectfully requested that the Examiner contact Applicant's attorney, Herbert F. Ruschmann, to discuss this matter before issuing a further Office Action.

**TIME EXTENSION REQUEST**

Applicant respectfully requests a two month extension of time for responding to the Office Action. Please charge the fee of \$430.00 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

67 and,

By H. F. Ruschmann  
Herbert F. Ruschmann  
Reg. No. 35,341  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

enc: Replacement drawing sheets of Figs. Figs. 1, 2(a) and 2(b).

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## APPENDIX I

### ALL PENDING CLAIMS WITH AMENDMENTS EFFECTED THEREIN

1. (Currently Amended) An optical element comprising:

a lens-barrel having an inner peripheral surface and an annular recess formed at an end of said inner peripheral surface having an annular recess inner surface extending axially;

an optically functional surface having a flange formed on the outer periphery thereof;

said flange having an outer peripheral cylindrical surface with a fitted portion fitted to the inner peripheral surface of said lens-barrel below said annular recess;

said flange having an adhering portion to be adhered to the lens-barrel which is an axially extending surface radially opposing said annular recess inner surface;

adhesive filled in said annular recess and on said adhering portion interconnecting said annular recess inner surface and said adhering portion; and

said flange having a raised annular portion extending axially and disposed radially inward of said adhering portion to prevent the adhesive from flowing to the optically functional surface.

2. (Currently Amended) The optical element according to claim 1, wherein:  
said raised annular portion has a first slant face on an outer peripheral side of said raised annular portion; and  
said inner peripheral surface of said annular recess is a second slant face extending from an upper end of said fitted portion.

3. (Currently Amended) The optical element according to claim 2, wherein the first slant face and the second slant face are on the same plane.

4. (Currently Amended) The optical element according to claim 1, wherein a space is formed between the raised annular portion and the optically functional surface.